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BELL, BOYD & LLOYD LLP				
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EXAMINER				
MOSSER, ROBERT E				
ART UNIT		PAPER NUMBER		
3714				
NOTIFICATION DATE		DELIVERY MODE		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PATENTS@BELLBOYD.COM

Office Action Summary**Application No.**

09/654,025

Applicant(s)

YOSELOFF ET AL.

Examiner

ROBERT MOSSER

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on May 21st, 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 23-65 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 23-65 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION



Claims 23-65 are pending.

This action is Non-Final.



Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on May 21st, 2008 has been entered.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.

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2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims **23, 27, 29-30, 33, 35-36, 38, 40-42, 45-46, 48, 50-51, 54-56**, and **58-65**, are rejected under 35 U.S.C. 103(a) as being unpatentable over Bennett (US 6,251,013) in view of O'Halloran (US 6,439,993) in further view of Schultz (US 5,332,228).

Claims **23, 27, 29-30, 33, 35-36, 38, 40-42, 45-46, 48, 50, 51, 54-56**: Bennett teaches a gaming device including a game operable upon a wager (*Bennett* Col 1:17-47), including a plurality of reels wherein each reel contain a plurality of locations for a plurality of symbols (*Bennett* Col 2:54-61) and wherein further the symbols are combinable to form a plurality of combinations including combinations of a non-linear scatter configuration (*Bennett* Col 3:14-22 & Figures 4-5). The device of Bennett further includes at least one winning condition wherein on the occurrence of said condition the device provides an award to the player through paying a prize (*Bennett* Col 1:55-61). The device of Bennett yet further includes a processor controlled display device (*Bennett* Col 2: 39-51, 6:13-19) for operating the device to perform the method of:

causing combinations of symbols to be displayed after the reels are spun;

responsive to the occurrence of a designated event causing the display device to visually distinguish a plurality of symbol locations from the remaining symbol locations on the reels;

cause the symbols displayed at each of the visually distinguished symbol locations to have a wild function wherein, the wild function is operable on one or more of the symbols in a displayed combination to increase the likelihood of meeting the winning condition but inoperable on other symbols;

determine if a winning condition is present accounting for the presence of the wild symbols; and

providing the player an award associated with the presence of winning conditions (*Bennett* Figure 9, Col 5:53-65).

In the above correlation Bennett teaches revealing a plurality of symbols and combinations thereof on the game reels, designating a symbol of the "ten" to be a wild symbol, which is a different characteristic from its original characteristic and applicable to only the additional identical "ten" symbols. After the transformation the device of Bennett inspects the displayed symbols to determine any winning combinations and payout any awards resultant thereof.

In yet additional embodiments Bennett teaches the re-spinning of reels upon designation during a first portion of a game and further embodiments that carry game features including symbol designation across a plurality of games (*Bennett* Col 5:33-52)

As taught above Bennett teaches the selection of wild symbols, re-spinning of reels upon designation, and the selection of scatter symbols in two separate embodiments however Bennett is arguably silent regarding the combination of a wild symbols, re-spinning of reels upon designation, and scatter symbols within the same embodiment. It would have been obvious to one of ordinary skill in the art at the time of

invention to have incorporate the wild symbol embodiment, re-spinning of reels upon designation, and the scatter symbol embodiment of Bennett into a singular embodiment with the payout limited effect according to the number of active paylines in order to increase the number of combinations resulting in a win as taught by Bennett (*Bennett* Col 1:48-52) and to further encourage the placement of max wagers per game that would activate all possible paylines.

Bennett teaches the incorporation of the features cited above however is arguably silent regarding the limiting of the active features to only the active paylines. In a related invention O'Halloran teaches a method and apparatus for a video wagering game including:

allowing the player to place a wager and select the win lines (alternatively described a paylines) from a plurality of available win lines through the use of a input device operable by the player to enable play on a spinning reel-slot-type video game event having a plurality of symbol positions located on each win line (*O'Halloran* Abstract & Col 1:5-19, 2:39-64);

displaying a plurality of randomly selected game symbols on a display after the spinning of the display reels , each symbol appearing in a designated symbol position on a reel to form combinations of symbols along the selectable paylines (*O'Halloran* Abstract, Col 1:5-19, 2:44-53, 3:31-37 & Figures 1, 4);

a plurality of winning conditions and awards associated with a plurality of the conditions(*O'Halloran* Col 1:12-16);

at least one wild function that is operable to assign a first characteristic to a first group of symbols in a first combination (or equivalently a first win line) that differs from the initial symbol characteristic (*O'Halloran* "@" Col 2:60-3:9), inoperable on a second combination (or equivalently a second win line) different from the first combination, and results in an increased likelihood of obtaining a winning condition (*O'Halloran* Col 2:46-3:17 & Figures 2-4);

upon the occurrence of a predetermined triggering event (*O'Halloran* Figure 2 Elm 30), randomly selecting between zero and fewer than a maximum number of viewable symbol positions (*O'Halloran* Fig 3 Elm 31) as a wild symbol position (*O'Halloran* Col 2:60-67);

converting (alternatively substituting or visually distinguishing) each symbol displayed within each selected wild symbol position to a wild symbol (*O'Halloran* Col 1:53-54; Fig 3 Elm 31) wherein the wild symbol operates on at least one but not all of the displayed game symbols (*O'Halloran* Fig 2,3,4,7; Col 2:48-54; Col 2:60-3:8); and

determining game outcomes based on the displayed game symbols and wild symbols and provide the player any awards associated with said game outcomes (*O'Halloran* Col 3:17-30).

It would have been obvious to one of ordinary skill in the art at the time of invention to have incorporated the selection of the at least one wild position as taught by *O'Halloran* into the game of Bennett because such a combination would have represented the combination of known elements and techniques yielding predictable results.

The combination of Bennett/O'Halloran however, is arguably silent regarding a separate selection of at least one indicia position separate from the selection of a payline yet in a related gaming device incorporating wild positions,

Schultz teaches a separate step of allowing a player to select at least one indicia position to be a wild position separate from the selection of a payline (*Shultz* Col 9:9-11). It would have been obvious to one of ordinary skill in the art at the time of invention to have incorporated the selection of the at least one wild position as taught by Shultz into the game of Bennett/O'Halloran because such a combination would have represented the combination of known elements and techniques yielding predictable results.

Claims **56, 59-61, and 63-65**: Bennett teaches visually distinguishing the selected symbols and their respective locations on the reels from a plurality of other symbols based whether or not the symbol has been assigned as a scatter payout symbol (Col 5:1-9).

Claims **58, and 62**: The method steps presented in the pending apparatus type claim are not bound by the order of their enactment and accordingly describe the process of Bennett as set forth in the rejection of at least claim **55** above.

Claims **24-26, 28, 31-32, 34, 37, 39, 43-44, 47, and 49** are rejected under 35 U.S.C. 103(a) as being unpatentable over Bennett (US 6,251,013) in view of O'Halloran

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(US 6,439,993) in further view of Schultz (US 5,332,228) in yet further view of Applicant admitted prior art.

Claims **24-26, 32, 34, 39, 44, and 49:** In addition to the invention of O'Halloran/Schultz as taught above, O'Halloran/Schultz is silent regarding the explicit teaching of a sequential or simultaneous unveiling of each of the symbols displayed at each one of the designated locations as wild symbols however, it is Applicant admitted prior art that the sequential or simultaneous unveiling of game outcomes is extremely old and well known in the art of gaming for drawing out the user's anticipation during game play and alternatively accelerate the process of game play resulting in comparatively faster game play and increase operator revenue associated therewith . It would have been obvious to one of ordinary skill in the art at the time of invention to have incorporated the sequential or simultaneous unveiling of each of the symbols displayed at each one of the designated locations as wild symbols in the prior art of O'Halloran/Schultz as presented above in order to draw out the user's anticipation during game play or alternatively accelerate the process of game play resulting in comparatively faster game play and increase operator revenue associated therewith.

Claims **28, 31, 37, 43, and 47:** In addition to the invention of O'Halloran/Schultz as taught above, O'Halloran/Schultz is silent regarding the explicit teaching of incorporating a server connected to the gaming device over a network for storing data related with the game however, it is Applicant admitted prior art that the

utilization of a server in combination with a gaming device, connected through a network and utilized for storing information associated with the game is extremely old and well known in the art and used for purposes including but not limited to the incorporation of player tracking systems, fraud prevention/detection, monetary handling services include cashless play, and the incorporation of pari-mutuel prize pools. It would have been obvious to one of ordinary skill in the art at the time of invention to have incorporated a server connected to the gaming device over a network for storing data related with the game in order to allow additional game features including those listed in the preceding sentence to be implemented in conjunction with the gaming device of O'Halloran/Schultz.

Claims **52-53** and **57**, are rejected under 35 U.S.C. 103(a) as being unpatentable over Bennett (US 6,251,013) in view of O'Halloran (US 6,439,993) in further view of Schultz (US 5,332,228) in yet further view of Applicant admitted prior art.

Claims **52-53**: In addition to the invention of Bennett/O'Halloran/Shultz as taught above, Bennett/ O'Halloran/Shultz is silent regarding the explicit teaching of a sequential or simultaneous unveiling of each of the symbols displayed at each one of the designated locations as wild symbols however, it is Applicant admitted prior art the sequential or simultaneous unveiling of game outcomes is extremely old and well known in the art of gaming for drawing out the user's anticipation during game play and alternatively accelerate the process of game play resulting in comparatively faster game

play and increase operator revenue associated therewith. It would have been obvious to one of ordinary skill in the art at the time of invention to have incorporated the sequential or simultaneous unveiling of each of the symbols displayed at each one of the designated locations as wild symbols in the prior art of Bennett/O'Halloran as presented above in order to draw out the user's anticipation during game play or alternatively accelerate the process of game play resulting in comparatively faster game play and increase operator revenue associated therewith.

Claim 57: In addition to the invention of Bennett/O'Halloran as taught above, Bennett/O'Halloran/Shultz is silent regarding the explicit teaching of incorporating a server connected to the gaming device over a network for storing data related with the game however, it is Applicant admitted prior art the utilization of a server in combination with a gaming device, connected through a network and utilized for storing information associated with the game is extremely old and well known in the art and used for purposes including but not limited to the incorporation of player tracking systems, fraud prevention/detection, monetary handling services include cashless play, and the incorporation of pari-mutuel prize pools. It would have been obvious to one of ordinary skill in the art at the time of invention to have incorporated a server connected to the gaming device over a network for storing data related with the game in order to allow additional game features including those listed in the preceding sentence to be implemented in conjunction with the gaming device of Bennett/O'Halloran/Shultz.

Response to Arguments

Applicant's arguments with respect to claims **23-65** have been considered but are moot in view of the new ground(s) of rejection.

Applicant's amendments of May 21st, 2008 include the base features previously presented as apparatus components additionally as program steps enacted by a processor and further include the incorporation of a re-spin feature. Upon reconsideration of the art of record the reference of Bennett was found to include teachings directed to this feature as applied above. Specifically additional embodiments of Bennett (Col 5:24-52) include teachings directed to re-spin events and the carrying of symbol designations across multiple rounds of play relevant to the newly amended features.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ROBERT MOSSER whose telephone number is (571)272-4451. The examiner can normally be reached on 8:30-4:30 Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Pezzuto can be reached on (571) 272-6996. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Robert E Pezzuto/
Supervisory Patent Examiner, Art Unit 3714
/R. M./
Examiner, Art Unit 3714